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SUPREME COURT, U.S

IN THE

Supreme Court of the United States

OCTOBER TERM, ~~1947~~ 1948

No. ~~176~~ 1485

THOGER GRONBERG JUNGERSEN,

Petitioner,

v.

ROBERT BADEN, ROSE BADEN, ALBERT FOSS and GLADYS FOSS, Co-partners, doing business under the name of BADEN & FOSS, and AXEL BROS., INC., et al.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

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New York, N. Y.,
April 28, 1948.

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TO THE HONORABLE THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Thoger Gronberg Jungersen, respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Second Circuit to review a judgment of that court entered March 10, 1948 (R. 220). A certified transcript of record, including the proceedings in said Circuit Court of Appeals has been filed herein pursuant to Rule 38.

Summary Statement of the Matter Involved

This is an action brought by petitioner in the United States District Court for the Southern District of New York for infringement of all six claims of his patent No.

2,118,468 which issued to him on May 24, 1938*. The first five claims relate to a method of casting jewelry of intricate design, and the sixth claim relates to the product thereof.

On the appeal, infringement was conceded. The only issue is validity of the claims (R. 210).

The patented method has been so extensively adopted by the jewelry manufacturing trade that former casting methods have become "of little commercial significance" (R. 30; 218). The patent has been the subject of litigation in the Fourth, Third and Second Circuits. The entire patent was held valid and infringed in *Jungersen* v. *Jenkins* (D. C., D. Md.), 30 F. Supp. 615, decided in August, 1939, and in *Jungersen* v. *Morris Kaysen Co.* (D. C., E. D. Pa.), 31 F. Supp. 703, decided in January, 1940. In the case of *Ostby & Barton Co.* v. *Jungersen*, 163 F. 2d 312 (1947), the Third Circuit Court of Appeals held claims 1-4 inclusive of the patent valid and claims 5 and 6 invalid. The District Court decision, which was affirmed, is reported in 65 F. Supp. 652.

In the instant case, the Second Circuit Court of Appeals by a divided court, Judge Learned Hand dissenting, affirmed the judgment of the District Court, holding all six claims invalid, thus creating a conflict of decision with the Third Circuit Court of Appeals with respect to the validity of claims 1-4 inclusive of the patent (Opinion R. 210; dissenting opinion R. 216).

In the case of *Ostby & Barton Co.* v. *Jungersen* (C. C. A. 3), 163 F. 2d 312, both parties have filed motions for leave to file petitions for rehearing of their petitions for writ of certiorari, previously denied at this Term, to re-

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* The action was commenced against Robert and Rose Baden and Albert and Gladys Foss (R. 3). On the eve of the trial, some seven corporations and fifteen individuals (comprising six partnerships) intervened and were made parties-defendant (R. 16, 24, 43).

view the judgment of the Third Circuit Court of Appeals in that case. In number 468, petitioner (plaintiff there) seeks review of that part of the judgment of the Third Circuit Court of Appeals holding claims 1-4 inclusive invalid; and in number 467, defendant (also petitioner here) seeks review of the part of that judgment holding claims 5 and 6 invalid.

Claim 5 is a method claim, differing only in scope from method claims 1-4 inclusive*. Claim 6 is for the product of the method of claim 5 and stands or falls with that claim. The decisions of the Second Circuit Courts holding all the claims invalid did not make any distinction of substance between the method of claims 1-4 inclusive and the method of claim 5.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1935 (28 U. S. C., Sec. 347).

The date of the judgment which petitioner seeks to have reviewed is March 10, 1948 (R. 220).

Question Presented

Whether claims 1-6 inclusive of Jungersen patent No. 2,118,468 are valid.

Specification of Errors to be Urged

The Circuit Court of Appeals for the Second Circuit erred:

1. In failing to hold claims 1-6 inclusive valid;

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* The District Court, after quoting claim 2, said "Claims 1, 3, 4 and 5 describe variants of the method" (R. 27).

2. In holding claims 1-5 inclusive invalid for want of invention over the cited references;

3. In holding claim 6 invalid for lack of novelty;

4. In affirming the judgment of the District Court.

Reasons Relied on for the Allowance of the Writ

A. The discretionary power of this Court to grant a writ of certiorari is invoked to review that part of the judgment holding claims 1-4 inclusive invalid upon the following ground:

The decision of the United States Circuit Court of Appeals for the Second Circuit in the present case, holding claims 1-4 inclusive invalid, is in direct conflict with the decision of the United States Circuit Court for the Third Circuit in *Ostby & Barton Co.* v. *Jungersen*, 163 F. 2d 312.

B. The discretionary power of this Court to grant a writ of certiorari to review the validity of claims 5 and 6 of the patent is invoked upon the following ground:

In the event the Court takes up for review the validity of claims 1-4 inclusive, it is desirable that the validity and scope of the other claims of the patent, namely, claims 5 and 6, be passed on at the same time by this Court because:

1. The courts of the Second Circuit, in holding all of the claims of the patent invalid, did not predicate their decision on any difference in substance between the method of claims 1-4 inclusive and the method of claim 5. Claim 6 is for the product of the method of claim 5 and stands or falls with that claim.

2. Claim 5, properly interpreted, can only cover the method disclosed in the patent and its equivalents. Consideration of the validity of claims 1-4 inclusive will neces-

sarily involve a consideration of what other methods of forming the primary mold and what other forces for introducing the wax into the primary molds are equivalents of those disclosed in the patent. The scope of inquiry will not therefore be enlarged by the inclusion of claims 5 and 6.

3. A decision of this Court upholding the validity of claims 1-4 inclusive without a consideration of claims 5 and 6 would leave the status of claims 5 and 6 and the scope of the patent in uncertainty in view of the decision of the District Court of Maryland in the Fourth Circuit upholding all six claims in *Jungersen* v. *Jenkins et al.*, 30 F. Supp. 615, and the dissenting opinion of Judge Learned Hand upholding the validity of the method of the patent, without distinction between the claims, as having "every hall-mark of a valid patent".

4. A consideration of the entire case is desirable in order to provide a definite and final adjudication of the validity and scope of a patent of importance in jewelry manufacture and in widespread use.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to review the judgment of that Court holding all six claims of the patent invalid and that said judgment be reversed.

Respectfully submitted,

WILLIAM H. DAVIS,
KARL W. FLOCKS,
Attorneys for Petitioner.

New York, N. Y.,
April 28, 1948.